

REMARKS

Claims 1-36 are pending and at issue in the application with claims 1, 12, 23, 33 and 36 being independent claims. Claim 36 has been amended. As a result, 5 independent claims remain in the application as previously paid for, and 36 total claims remain in the application as previously paid for. The applicants believe no fee is due. However, the Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

The action rejects claims 1-36 as unpatentable over Morrow et al. (U.S. Appl. Pub. No. 2004/0054952) in view of Sarbin et al. (U.S. Patent No. 5,179,517). The applicants respectfully traverse the rejections.

Each of claims 1-35 recites a gaming apparatus or slot machine that includes a storage device adapted to read from and write to a removable storage memory, and a controller programmed to record information regarding the gaming apparatus or slot machine on the removable storage memory, where the gaming apparatus or slot machine is operable when the removable storage memory is removed. Claim 36 recites a fifth memory portion of a memory physically configured in accordance with program instructions that would cause a gaming apparatus to be operable when a removable storage memory is removed from the gaming apparatus.

The action does not establish a *prima facie* case of obviousness, because the action has not cited a combination of references that discloses each and every element as required by claims 1-36. MPEP 2142 requires that to establish a *prima facie* case of obviousness, the combination of references must teach or suggest all the claim limitations. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The combination of Morrow et al. and Sarbin et al. fails to disclose each and every element in claims 1-36. In particular, the portions of Morrow et al. and Sarbin et al. as relied upon by the action do not disclose or suggest that a gaming apparatus or slot machine remains operable when a removable storage memory is removed.

Morrow et al. discloses a storage device, which may be a persistent storage media 90, of a gaming machine to store event messages for a detected system event in a log file. (See paragraphs [0056]-[0061] and claims 100 and 106, as cited by the action). The persistent storage media may be a removable storage unit such a CD-ROM reader, a WORM device, a CD-RW device, a floppy disk device, a removable hard disk device, a ZIP disk device, a JAZZ disk device, a DVD device, a removable flash memory device, or a hard card device. (See paragraph [0013], as cited by the action). However, the action has not demonstrated that Morrow et al. discloses or suggests that the gaming machine is operable when the storage device (e.g., persistent storage media) is removed from the gaming apparatus. As seen on page 3, while the action states "said gaming apparatus is operable when said removable storage memory is removed from said gaming apparatus," the action does not point to any disclosure within Morrow et al. that supports this contention, or otherwise assert that such a feature would be suggested or inherent in Morrow et al.

Indeed, Morrow et al. does not appear to provide any disclosure that a gaming machine 10 configured with the storage device provided as a removable storage unit remains operable if the storage device is removed (e.g., operable independent of the now-removed storage device). Indeed, a gaming machine 10 that is configured with a storage device, even if removable, may consequently be dependent upon the inclusion of the storage device, and removal of the storage device requires its subsequent reinsertion or replacement in order for the gaming machine 10 to operate. As a result, it cannot be automatically assumed that the gaming machine 10 remains operable once the storage device is removed absent specific disclosure to this effect. Accordingly, the Morrow et al. does not disclose or suggest a removable storage memory such that a gaming machine remains operable upon its removal, as recited by the claims, nor would such a feature be necessarily inherent from the disclosure of Morrow et al.

Sarbin et al. also does not disclose or suggest that a gaming apparatus or slot machine remains operable when a removable storage memory is removed, nor has the present action provided (or otherwise argued) Sarbin et al. for this purpose.

It is clear that a *prima facie* case of obviousness cannot be established where all the limitations of a claimed combination are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03. Accordingly,

the action has not presented a *prima facie* case of obviousness for claims 1-36, and the rejections of claims 1-36 cannot be sustained.

The action also does not establish a *prima facie* case of obviousness with respect to claims 11 and 22. In particular, while the action appears to address each of the remaining claims, the action does not address the limitations of claim 11 and 22 (e.g., "said gaming apparatuses are interconnected via the Internet"). Indeed, while page 2 of the action asserts that all of claims 1-36 are rejected as unpatentable over Morrow et al. and Sarbin et al., a review of the action clearly demonstrates that claims 11 and 22 have not been addressed or otherwise provide reasons for a rejection of claims 11 and 22. The action does not cite to any portion of either Morrow et al. or Sarbin et al. as disclosing gaming apparatuses interconnected via the Internet, nor address these features in any manner. The Office bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of obviousness. The Office has not met that burden in the action, because the action has failed to properly account for the claim language of claims 11 and 22. See MPEP 706.02(j), 2142, 2143. Should any subsequent action present a rejection against either of claims 11 or 22, such a rejection must be presented as new grounds in a non-final action, because it is clear the present action has not addressed these claims.

To the extent the action notes that particular columns and line numbers in the references as applied to the claims have been provided for the convenience of the applicant and that other passages and figures may apply as well (see action page 5), the applicants respectfully note that MPEP 2142 requires that the burden is upon the Office to establish a *prima facie* case of obviousness by factually supporting any conclusion of obviousness. MPEP 706.02(j) requires that an action include "the relevant teachings of the prior art relied upon." In other words, it is not incumbent upon the applicant to have to guess where the references may disclose the features of the claims, but rather, it is entirely incumbent upon the Office to demonstrate how each feature of the claim is disclosed or suggested by the references.

To the extent the references may disclose other passages which the Office may consider applicable to the claims, the applicants are not required to engage in conjecture as to how the Office may interpret or otherwise rely upon the references. If the action means to rely upon the entire disclosure of the references, the rejections would necessarily be

considered an omnibus rejection. However, MPEP 707.07(d) clearly precludes omnibus rejections. Accordingly, it remains the burden of the Office to provide the reasons for each rejection, including specific citations to the references. Should the Office subsequently provide new reasons for rejecting the claims based on currently uncited portions of the references, such a rejection would necessarily constitute new grounds for rejection.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. Should the examiner wish to discuss the foregoing, or any matter of form, in an effort to advance this application towards allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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